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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/672,934	09/28/2000	John Hadfield	00AB183	7590

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EXAMINER

GART, MATTHEW S

ART UNIT	PAPER NUMBER
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3625

DATE MAILED: 11/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/672,934

Applicant(s)

HADFIELD ET AL.

Examiner

Matthew s Gart

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 16 August 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-11, 20, 22-25, 31-35 and 37-54 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11, 20, 22-25, 31-35 and 37-54 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 September 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

Claims 1-11, 20, 22-25, 27-35 and 37-54 are pending in the present application. Claims 21 and 36 were canceled and new claims 47-54 were added via the Applicant's Amendment filed 3/17/2004. Claims 12-19 and 26-30 were previously canceled in the Response to Restriction Requirement filed on 2/21/2003.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**Claim 1-11, 20, 22-25, 31-35 and 37-54 are rejected under 35 U.S.C. 102(e) as being anticipated by Skoolicas U.S. Patent No. 6,230,403.**

Referring to claim 1. Skoolicas discloses a method for selling engineered electrical systems (column 2, lines 26-51), the method comprising the steps of:

- Generating a database for an electrical system comprising a plurality of programmable devices, the database including device designation data (column 32, lines 36-62);
- Soliciting an order for the system (column 31, lines 48-59);

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- Assembling the system including the plurality of programmable devices (column 32, lines 36-62); and
- Configuring memory objects within the devices by downloading at least the device designation data from the database (column 2, lines 42-51 and column 34, lines 41-57).

Referring to claim 2. Skoolicas further discloses a method comprising the step of designing the electrical system including the plurality of programmable devices (column 2, lines 42-51 and column 34, lines 41-57).

Referring to claim 3. Skoolicas further discloses a method wherein the device designation data includes data representative of a physical location of a device in the system (column 32, lines 36-62).

The Examiner notes, the data included within the designation data qualifies as descriptive material since it is directed to the content of data, not structure or an action or step. The particular data stored does not patentably distinguish the claimed method and is given little patentable weight.

Referring to claim 4. Skoolicas further discloses a method wherein the device designation data includes data representative of a function of a device in the system (column 32, lines 36-62).

The Examiner notes, the data included within the designation data qualifies as descriptive material since it is directed to the content of data, not structure or an action or step. The particular data stored does not patentably distinguish the claimed method and is given little patentable weight.

Referring to claim 5. Skoolicas further discloses a method wherein the step of soliciting the order includes computing price data, based upon the database (column 31, lines 48-59).

Referring to claim 6. Skoolicas further discloses a method comprising the step of storing the database in a computer coupled to the system (Figure 5).

Referring to claim 7. Skoolicas further discloses a method wherein the system includes a plurality of subassemblies, at least a portion of the subassemblies including at least one programmable device, and wherein the memory objects of the programmable devices are configured after arrangement of the devices on the subassemblies (column 2, lines 42-51 and column 34, lines 41-57).

Referring to claim 8. Skoolicas further discloses a method wherein the memory objects of the programmable devices are configured prior to arrangement of the subassemblies in the system (column 2, lines 42-51 and column 34, lines 41-57).

Referring to claim 9. Skoolicas further discloses a method wherein the memory objects of the programmable devices are configured after arrangement of the subassemblies in the system (column 2, lines 42-51 and column 34, lines 41-57).

Referring to claim 10. Skoolicas further discloses a method wherein the devices include electrical power switching devices mounted within an enclosure (column 1, line 4 to column 2, line 24).

Referring to claim 11. Skoolicas further discloses a method wherein the system includes a motor control center (column 1, line 4 to column 2, line 24).

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Referring to claim 20. Claim 20 is rejected under the same rational as set forth above in claim 1.

Referring to claim 22. Claim 22 is rejected under the same rational as set forth above in claim 3.

Referring to claim 23. Skoolicas further discloses a method wherein the step of programming the programmable components is performed following final assembly of the components in the system (column 2, lines 42-51 and column 34, lines 41-57).

Referring to claim 24. Skoolicas further discloses a method wherein the step of assembling the system includes coupling the components to a data network in the system for accessing data from each programmable component (column 20, lines 1-14).

Referring to claim 25. Cremon further discloses a method wherein the programmable components are programmed via the data network (Figure 5).

Referring to claim 31. Claim 31 is rejected under the same rational as set forth above in claim 1.

Referring to claim 32. Claim 32 is rejected under the same rational as set forth above in claim 4.

Referring to claim 33. Claim 33 is rejected under the same rational as set forth above in claim 3.

Referring to claim 34. Claim 34 is rejected under the same rational as set forth above in claim 1.

Referring to claim 35. Claim 35 is rejected under the same rational as set forth above in claim 4.

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Referring to claim 37. Claim 37 is rejected under the same rational as set forth above in claim 6.

Referring to claim 38. Claim 38 is rejected under the same rational as set forth above in claim 7.

Referring to claim 39. Claim 39 is rejected under the same rational as set forth above in claim 8.

Referring to claim 40. Claim 40 is rejected under the same rational as set forth above in claim 9.

Referring to claim 41. Claim 41 is rejected under the same rational as set forth above in claim 7.

Referring to claim 42. Claim 42 is rejected under the same rational as set forth above in claim 1.

Referring to claim 43. Claim 43 is rejected under the same rational as set forth above in claim 3.

Referring to claim 44. Claim 44 is rejected under the same rational as set forth above in claim 9.

Referring to claim 45. Claim 45 is rejected under the same rational as set forth above in claim 24.

Referring to claim 46. Claim 46 is rejected under the same rational as set forth above in claim 25.

Referring to new claims 47-54. New claims 47-54 are rejected under the same rationale as set forth above in claims 1-11, 20, 22-25, 27-35 and 37-46.

***Response to Arguments***

Applicant's arguments with respect to the claims are not persuasive. The Applicant alleged that the Examiner has not addressed without any specificity all of the claim groups.

The Examiner has cited particular columns and line numbers in the references as applied to a representative claim group for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the representative claims, other passages and figures may apply as well. It is respectfully requested that, in preparing responses, the applicant fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

The Applicant argues, "Claim 1 discloses that data is downloaded into the devices from a database, whereby Skoolicas discloses data that is indicated by the database."

The Examiner notes (with reference to Skoolicas), at microprocessor programming station **702**, the programmable devices are programmed using programming specifications **702A** provided by the SMI. The SMI (system manufacturing interface) receives raw system specifications upon the receipt of an order from the ordering system. After receiving the raw specifications, the SMI generates all



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of the detailed manufacturing specifications for all of the components necessary to build the system (including programmable device specifications).

Claim 1 of the instant application is not limited to direct downloading of information into the programmable devices. Claim 1 recites, "Configuring memory objects within the devices by downloading at least the device designation data from the database." Claim 1 does not recite that the information is directly downloaded into the programmable device. Claim 1 is interpreted as a method wherein information is downloaded to a user (i.e., via a printout or display) then using the information, a user could program the programmable device. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

The Applicant notes that the application makes clear that device designation data relates to various attributes of the device itself, such as its function and physical location.

The Examiner notes, in reference to all the claims, the data included within the designation data qualifies as descriptive material since it is directed to the content of data, not structure or an action or step. The particular data stored does not patentably distinguish the claimed method and is given little patentable weight.

The Applicant argues that the designation data provided in the database recited in claim 1 is much more than nonfunctional descriptive material.

The Examiner notes, the designation data, is not functionally involved in the steps recited. For example, claim 3 discloses that the device designation data includes data representative of a physical location of a device in the system. This device designation data could include any number of a plurality of data elements. The generating, soliciting, assembling and configuring steps would be performed the same regardless of the data being downloaded. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability.

The Examiner further notes, claim 20 is rejected under the same rationale as set forth above in claim 1. Claim 20 specifies the type of designation data (i.e. component layout). This data qualifies as nonfunctional descriptive material because it is not functionally related to the method steps and could have included any number of a plurality of data types. The generating, assembling and programming steps would be performed the same regardless of the type of data being downloaded. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability.

Referring to claim 31, the Applicant argues that the Examiner has made no attempt to analyze this claim in any detail, preferring to depend upon the rationale used to reject claim 1. Furthermore the Applicant notes that claim 31 is a system claim not a method claim.

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The Examiner notes, the system as recited in claim 31 aims to solve the same problem as the method recited in claim 1. In both claim 1 and claim 31 the present invention relates generally to the field of electrical control and monitoring systems, and more particularly to a system and method that integrates functions of design, sales and marketing, manufacturing, and programming of system components."

This is further demonstrated via the Applicant's remarks filed 10/20/2003 and 3/17/2004. The Applicant stated in his remarks filed 10/20/2003, "All of the independent claims, in similar terminology, recite configuring memory objects or programming programmable components based upon such a database. The database is generated for the programmable devices or components, and is used for soliciting an order and assembling a system. As noted in the present application, the use of the same database for configuring and selling the system, and for programming the components specified greatly enhances the efficiency and consistency between design, sale and implementation.

This Applicant's further stated in his remarks filed 3/17/2004, "...the present application currently includes seven independent claims, namely, claims 1, 20, 31, 34, 42, 47, and 50. In a broad sense, each of these claims recites configuring or programming a component or object by downloading items from a database into the memory object or programmable component." Throughout the prosecution of this application arguments have been presented and considered based on a representative claim group in order to simplify prosecution.

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication should be directed to Matthew Gart whose telephone number is 703-305-5355. This examiner can normally be reached Monday-Friday, 8:30AM-5:30PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ms. Wynn Coggins can be reached on 703-308-1344. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-7239 for regular communications and 703-746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

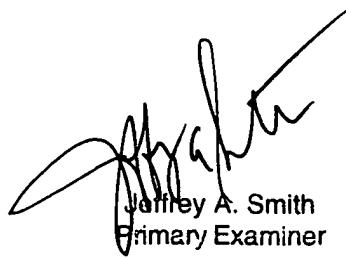
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A handwritten signature in black ink, appearing to be 'MSG', written in a cursive style.

MSG  
Patent Examiner  
November 2, 2004

A handwritten signature in black ink, appearing to be 'Jeffrey A. Smith', written in a cursive style.

Jeffrey A. Smith  
Primary Examiner